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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,387	01/31/2001	Herbert F. Cattell	10010009-1	7825

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EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,387

Applicant(s)

CATTELL, HERBERT F.

Examiner

Marianne P. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,13,25,27-30,32,33 and 37-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5,7-11,13,37-39 and 44 is/are allowed.
- 6) ☒ Claim(s) 6,25,27-30,32,33,40-43 and 45-55 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Applicant's arguments filed 7/14/04 have been fully considered but they are not fully persuasive.

Claims 46-55 have been newly introduced. Claims 1-3, 5-11, 13, 25, 27-30, 32-33, and 37-55 are under consideration.

The prior art rejections have been withdrawn with respect to the method claims in view of the amendment to the claims concerning retrieving updated biological function data.

Claim Objections

Claim 49 is objected to because of the following informalities: The claim contains a typographical error, "claim 46wherein said..." Appropriate correction is required.

Claim 6 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

As requested by applicant, this objection is being made in addition to the rejection under 35 USC 112, 2nd paragraph.

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Applicant is advised that should claim 45 be found allowable, claim 55 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). These claims are directed to the same apparatus.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 30, 32-33, 40-43, 46-51 and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claim 30 has been amended to recite a processor “adapted to retrieve updated feature characteristic data.” No basis has been pointed to for this amendment and none is apparent. The specification does not disclose particularly altering any processor to result in the particular functionality. Likewise, no basis is seen for the processors “adapted” in claims 32, 33, and 40-43.

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Claims 46-51 and 54 are newly introduced claims. Applicant states that basis is in the originally filed claims and throughout the specification; however, support for the methods with the recited steps is not seen. Applicant is requested to point to the page and line number supporting the claims.

Claims 6, 30, 32-33, 40-43, 45, 47-50, 52, and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 remains confusing in that claim 1 already performs the association set forth in this claim. As such, it appears that the claim is not further limiting. Applicant's argument is not persuasive. As the specification and claims require no particular type of association, the retrieval step implicitly requires association. Again, the similar portion of claim 28 is considered to be redundant to step (c) of the claim. Applicant is requested to explain how the retrieval required by claims 6 and 28 can be performed with no association of any kind. Alternatively, applicant is requested to make clear the specific type of association that the claim intends.

Claims 30, 32-33, and 40-43 are confusing as it is unclear what structural change must occur to the processor to permit the recited functionality. As such, it is unclear what processors are embraced by the claims.

Claims 47-50 lack antecedent basis in claim 46 for a database.

Claim 52 is confusing for being dependent upon cancelled claim 19.

Claims 45 and 55 are confusing in including a limitation with respect to the addressable biopolymer regions. This does not appear to modify any of the elements of the apparatus of

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claim 25. Claim 25 does not require an array only an array reader. This limitation does not clearly modify or further limit the type of array reader required by the claim. Clarification is requested.

Claim Rejections - 35 USC § 102

Claims 25, 27, 28, 29, 45, and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by any of Muraca (U.S. Patent Application Publication No. 2002/0168639), Doung et al. (U.S. Patent Application Publication 2002/0177135).

Claim 25 is directed to an apparatus comprising an array reader, a reader which reads an identifier, and a processor. Claims 45 and 55 specify the type of biopolymer region.

Claim 27 further requires a portable storage medium.

Claim 28 is directed to an apparatus comprising an array reader, a reader which reads an identifier, and a processor. Claim 29 additionally requires a communication module.

Both Muraca and Doung et al. are applied as in previous Office actions and teach an apparatus with these structural elements. The courts have stated that claims drawn to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F. 2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (see MPEP 2114). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim, *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987). Note that claims 45 and 55 do not further limit the apparatus elements. See above.

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Claims 25, 27, 28, 29, 45, and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Schembri (GB 2,319,833).

Claim 25 is directed to an apparatus comprising an array reader, a reader which reads an identifier, and a processor. Claims 45 and 55 specify the type of biopolymer region.

Claim 27 further requires a portable storage medium.

Claim 28 is directed to an apparatus comprising an array reader, a reader which reads an identifier, and a processor. Claim 29 additionally requires a communication module.

Schembri et al. is applied as in previous Office actions and teaches an apparatus with these structural elements. The courts have stated that claims drawn to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F. 2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (see MPEP 2114). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim, *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987). Note that claims 45 and 55 do not further limit the apparatus elements. See above.

Claims 25, 28, 45, and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellson et al. (US 2002/0086319 A1).

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Ellson et al. is applied as in the prior Office action and teaches an apparatus with the recited structural elements. The courts have stated that claims drawn to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F. 2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (see MPEP 2114). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim, *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987). Note that claims 45 and 55 do not further limit the apparatus elements. See above.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marianne P. Allen

Marianne P. Allen

Primary Examiner

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9/28/04

mpa